

The Objection to the Drawings Should Be Withdrawn

The Examiner has objected to the drawings as containing excessive descriptive language/material not contained in the specification. Specifically, the Examiner objects that the structure of Figure 3 is not contained in the specification. Although the Applicants believe that the Figures are correctly described in the specification, in order to expedite prosecution, the Applicants have cancelled Figures 2 and 3. Applicant has amended the specification at page 6 to add a “Brief Description of the Drawings” paragraph as well as amending page 11, lines 22 and 24 to remove reference to Figures 1 and 2. No new matter is added by way of these amendments. Therefore, it is requested that this rejection be withdrawn.

The Rejections Under 35 U.S.C. §102(b) Should be Withdrawn

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,255,327 (“Endo”). This rejection is respectfully traversed.

The Examiner suggests that Endo meets all the limitations of the present claims. The applicant respectfully disagrees. The Examiner states that “...the Endo vibration device when applied to the breast (col. 2, lines 67-68) would inherently provide the desired result of the method claim (even if very limited).” See page 6, lines 1-12. The Applicants respectfully disagree.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. See Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995). Endo does not teach or suggest a method for increasing a retrievable cell amount in a breast duct by applying

vibration to the duct to induce cell sloughing within the duct. Nowhere in Endo is there any mention of the use of vibration to increase cell sloughing within a breast duct. The Examiner points to Endo and states that the mere mention of any application of vibration to a breast anticipates the method of the present invention. The increase in the retrievable amount of cells in a breast duct by the application of vibration is an unexpected result which is clearly not anticipated by Endo. To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill”. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency. See *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Since the Examiner cannot point to any teaching in Endo that the application of vibration to a breast would increase the cellular contents of the fluid within breast duct, Endo cannot anticipate claim 1 and 3 of the present invention. Withdrawal of the rejection is requested.

Likewise, there is no description in Endo of the use of ultrasound as described in Claim 2 or the use of heat and massage as described in Claim 3. The Examiner has rejected these claims as being anticipated by Endo, yet the Examiner has no pointed to any teaching or suggestion within Endo to anticipate these limitations. Clearly, Claims 2 and 3 are not anticipated by Endo. Withdrawal of the rejection is requested.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,765,403 (“Brenden”). This rejection is respectfully traversed.

The Examiner suggests that Brenden "...discloses an ultrasound device that meets the limitation of the claims since Brenden discloses an ultrasonic vibration to the breast. See page, lines 1-2. The Applicants respectfully disagree.

As mentioned previously, the mere disclosure of a device that renders vibration to the entire breast does not anticipate a method for increasing a retrievable cell amount in a breast duct by applying vibration to the duct to induce cell sloughing within the duct. The increase in the retrievable amount of cells in a breast duct by the application of vibration is an unexpected result which is clearly not anticipated by Brenden. Withdrawal of the rejection is requested.

Likewise, there is no description in Brenden of the use of heat and massage as described in Claim 3. The Examiner has rejected this claim as being anticipated by Brenden, yet the Examiner has no pointed to any teaching or suggestion within Brenden to anticipate this limitation. Clearly, Claim 3 is not anticipated by Brenden. Withdrawal of the rejection is requested.

For all of the above discussed reasons, the Patents to Endo and Brenden do not disclose the recited device. Additionally, it would not have been obvious to one of ordinary skill in the art to modify the vibration device of Endo or Brenden so that it could increase a retrievable cell amount in a breast duct because no motivation exists for such a modification. Withdrawal of the rejections under 35 U.S.C. 102(b) is requested.

The rejection under 35 USC 103(a) over Hung in view of Endo

Claims 1-5 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,413,228 (“Hung”) in view of U.S. Patent No. 5,255,327 (“Endo”). This rejection is respectfully traversed.

Application 10/825,752 and Patent 6,413,228 were, at the time the invention of Application 10/825,752 was made, owned by or subject to an obligation of assignment to Cytac Corporation.

Withdrawal of this rejection under 35 USC 103(a) is respectfully requested.

Rejection Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

Applicant asserts that a terminal disclaimer may be filed at the time the claims are indicated to be allowable. Applicants appreciate the examiner holding this issue in abeyance until such a time that there is allowable subject matter.

CONCLUSION

In light of the amendments and arguments presented above, Applicants respectfully submit that the claims are in condition for allowance. Early notice to this effect is solicited.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR

§ 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 502855 referencing attorney docket number 12.023011-CIP.

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Respectfully submitted,



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